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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,233	11/13/2003	Robert S. Bierwith	011674-001211US	9677

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BATSON, VICTOR D

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,233

Applicant(s)

BIERWITH, ROBERT S.

Examiner

Victor Batson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3,11-14,18,26 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of prior U.S. Patent No. 6,751,897. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,751,897 B2. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the invention of claims 1,2,4-10,16,17,19-25 claims a lip assembly and a bucket assembly similar to the lip assembly and bucket assembly claimed in claims 1-7 of prior U.S. Patent No. 6,751,897, only without the specifics of the projections and valleys or block members which would be obvious to eliminate.

Claim Objections

Claims 11-14,18,22 are objected to because of the following informalities: In claim 11 line 4, it appears that "the" should be inserted before "front". In claim 18 line 2, "the second plurality of holes" lacks proper antecedent basis and it appears that claim 18 should depend from claim 17. In claim 22 line 4, it appears that "the" should be inserted before "lip via". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,7,8,9,15,17,19,20,21,22,25 are rejected under 35 U.S.C. 102(b) as being anticipated by Klett et al. (3,864,853).

Klett et al. discloses a lip assembly including a lip 12, a plurality of support members 16, and a plurality of tooth assemblies 11. Concerning the limitation of

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lip shrouds, every other tooth 11 is considered a lip shroud since they inherently help to protect the lip.

Claims 1,3,7,10,15,17,19,25 are rejected under 35 U.S.C. 102(b) as being anticipated by Irving (5,553,409).

Irving discloses a lip assembly including a lip 11, a plurality of support members 14, and a plurality of tooth assemblies 12. Concerning the limitation of lip shrouds, section 15 is considered a lip shroud.

Claims 1,2,7,15,16,17,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornelius (5,852,888).

Cornelius discloses a lip assembly including a lip 12 & 14, a plurality of support members 18, and a plurality of tooth assemblies 16. Concerning the limitation of lip shrouds, every other tooth is considered a lip shroud since they inherently help to protect the lip.

Claims 1,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierwith (4,413,432).

Bierwith discloses a lip assembly including a lip, a plurality of support members (unnumbered, but shown in figure 3 between projections 13), and a plurality of tooth assemblies 20. Concerning the limitation of lip shrouds, every other tooth is considered a lip shroud since they inherently help to protect the lip.

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Claims 1,2,3,5,7,15,17,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bierwith (5,526,592).

Bierwith discloses a lip assembly including a lip, a plurality of support members 50, and a plurality of tooth assemblies including adapter shrouds and lip shrouds 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 & 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klett et al. (3,864,853).

Klett et al., discloses a lip assembly as described previously, but lacks specifying that the lip is comprised of steel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the lip from steel since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Klett et al. discloses the claimed invention except for only a single rib 16 is present between holes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a pair of ribs in place of the

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single rib, since it has been held that mere duplication of the essential working parts of a device involves only routing skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 5,6,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius (5,852,888) in view of Bierwith (5,526,592).

Cornelius discloses a lip assembly as described previously, but lacks using an adaptor shroud.

Bierwith teaches that it is known in the art to use an adaptor shroud with a tooth assembly for an excavator. The use of a shroud adds protection from damage and wear experienced during excavation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the device of Cornelius, by using an adaptor shroud as taught by Bierwith, to provide added protection from damage and wear during excavation.

Concerning claim 6, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the lip from steel since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 4,11-14,18,26 are allowed.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (703) 305-6356. The examiner can normally be reached on Monday through Friday (except Wednesday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (703) 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 11, 2004



Victor Batson
Primary Examiner
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